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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/815,362 | 03/21/2001 | Ken Chow | 17243CIP3(AP) | 4078 |

7590 02/12/2003

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EXAMINER

ANDERSON, REBECCA L

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------|-----------------------------|--|
| Office Action Summary | Application No. 09/815,362 | Applicant(s) CHOW ET AL. | |
| | Examiner Rebecca L Anderson | Art Unit 1626 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-108 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☒ Claim(s) 108 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-4, 7-15, 20, 21, 26, 38, 50-55, 71, 89, 97, 101, 103 and 104 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 5,6,16-19,22-25,27-37,39-45,47-49,56-70,72-88,90-96,98-100,102 and 105-107.

DETAILED ACTION

Claims 1-108 are currently pending in the instant application (Note: Page 4 of Amendment B filed 3 May 2002 states, "Applicant notes that claim 109, added by amendment in the communication, stands unrejected." However, no amendment adding a claim 109 is found in amendment B or amendment A, filed 20 December 2001. Therefore, claims 1-108 are currently pending in the instant application.) Claim 108 is allowable over the prior art of record. Claims 1-4, 7-15, 20, 21, 26, 38, 46, 50-55, 71, 89, 97, 101, 103 and 104 are objected to as containing non-elected subject matter. Claims 5, 6, 16-19, 22-25, 27-37, 39-45, 47-49, 56-70, 72-88, 90-96, 98-100, 102 and 105-107 are withdrawn from consideration as being drawn to non-elected inventions.

Inventorship

In view of the papers filed 12 March 2002, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by adding Dario M. Gomez as a joint inventor

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

Specification

The disclosure is objected to because of the following informalities: page 128 is missing.

Appropriate correction is required.

Election/Restrictions

Applicant's election of the species of N3, found on page 102 of the instant specification, in Paper No. 13 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

With the identification of the above noted species, the examiner will identify a generic concept, inclusive of said species, for examination.

The generic concept is that of the compound as found in claim 1 wherein:

x is 1 or 2;

R₁ is independently selected from the group consisting of H; halogen; C₁₋₄alkyl; C₁₋₄alkenyl; C₁₋₄alkynyl; --COR₄ where **R₄** is H, C₁₋₄alkyl or C₁₋₄alkoxy; C₃₋₆cycloalkyl; aryl, cyano, nitro; trihalomethyl; oxo; or --(CH₂)_n-X-(CH₂)_m-(R₅)_o where **X** is O, S or N, **n** is 0-3, **m** is 0-3, **o** is 0-1, and **R₅** is methyl or H₁₋₂;

R₂ and **R₃** together consist of a partly saturated ring structure containing one double bond, wherein the double bond is shared with the ring including Y, having the formula --(C(R₆)_p)_q-X_s-(C(R₆)_p)_r-X_t-(C(R₆)_p)_u where each **R₆** is independently selected from the group consisting of H; halogen; C₁₋₄alkyl; C₁₋₄alkenyl; C₁₋₄alkynyl; --COR₄ where **R₄** is H, C₁₋₄alkyl or C₁₋₄alkoxy; C₃₋₆cycloalkyl; aryl; cyano; nitro; trihalomethyl and oxo where each **p** is independently 1 or 2; **q** is 0-4, **r** is 0-4, **u** is 0-4; each **X** is independently O, S or N and **s** is 0; **t** is 0; provided that **q** + **r** + **u** + **s** + **t** is 4;

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and the ring including Y is a cyclohexane ring containing one double bond, which is shared with the ring formed by R2 and R3.

The remaining subject matter of claims 1-4, 7-15, 20, 21, 26, 38, 46, 50-55, 71, 89, 97, 101, 103 and 104 and the subject matter of claims 5, 6, 16-19, 22-25, 27-37, 39-45, 47-49, 56-70, 72-88, 90-96, 98-100, 102 and 105-107 stands withdrawn, 37 CFR 1.142(b), as being for non-elected inventions. The withdrawn subject matter of the claims is properly restricted as said subject matter differs materially in structure and element from the elected subject matter so as to be patentably distinct, i.e. a reference which anticipated but the elected subject matter would not even render obvious the non-elected subject matter. Additionally, the fields of search are not co-extensive.

Accordingly, the claims are drawn to more than a single invention and restriction as has been required is proper, 37 CFR 1.142(a).

Claim Objections

Claims 1-4, 7-15, 20, 21, 26, 38, 46, 50-55, 71, 89, 97, 101, 103 and 104 are objected to as containing non-elected subject matter. The claims presented drawn solely to the elected subject matter as indicated supra would appear allowable over the prior art of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (703) 605-1157. Mrs. Anderson can normally be reached Monday through Friday 7:00AM to 3:30PM.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph McKane, can be reached at (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone numbers are (703) 308-1235 and (703) 308-0196.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45AM to 4:45PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4242, (703) 305-3592, and (703) 305-3014.

RA

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